REMARKS

Applicant has amended Claims 2, 3, 7, 8, 10, 11, 12 and 15 – 18 to remove informalities and to more particularly point out and distinctly claim the invention. Applicant presents new Claim 19 to recite the relationship between the gasket's claimed compression rib and the generally planar gasket receiving surface from which it extends (see Specification, Para. 19, lines 9 – 10, Para. 23, lines 1 – 2 and Para. 24, lines 1- 6), a relationship not seen in any of the art made of record.

The Examiner asserts that the instant application cannot claim priority from Application No. 10/151,361 as they were not copending. Applicant respectfully disagrees. Application No. 10/151,361 was filed on May 17, 2002 and issued as U.S. Patent No. 6,760,986 B1 on July 13, 2004. The instant application was filed on January 23, 2004, clearly during the time that the parent application was still pending. Applicant theorizes that the Examiner may have mistaken a "7" for a "1". Applicant has amended the first paragraph of the specification to recite the patent number and issue date of the parent application.

The Examiner has rejected Claim 10 as indefinite under 35 USC § 112, because it was unclear as to whether the two new channels included the channel recited in Claim 15. Applicant has amended Claim 10 to make clear that the channel of Claim 15 is one of the channels recited in Claim 10.

The Examiner has rejected the claims under the doctrine of obviousness-type double patenting in view of (1) U.S. Patent No. 6,760,986 and (provisionally)(2) pending U.S. Patent Application No. 10/315,424. In response, Applicant submits a terminal disclaimer in compliance with 37 CFR 1.321(c) to overcome these grounds for rejection.

The Examiner rejects the following claims as unpatentable over the following prior art:

(a) Claims 11, 15 – 17, 2 – 4 and 7 – 9, as anticipated by Leopold et al., U.S. Patent No. 1,664,302 ("Leopold et al.")

(b) Claim 18 as anticipated by Dutt, U.S. Patent No. 4,308,965 ("Dutt").

(c) Claims 15, 10 and 11 as obvious in view of a combination of Gonzalez, U.S. Patent No. 5,255,166 ("Gonzalez"), and Means, U.S. Patent No. 4,813,167 ("Means").

(d) Claim 12 as obvious in view of either Leopold et al. or Gonzalez, and further in view of Applicant's alleged statement that the use of gaskets with ultraviolet inhibitors is known in the art.

(e) Claim 18 as obvious in view of a combination of Leopold et al. and Yesbick, U.S. Patent No. 5,787,625.

Before discussing each of these grounds for rejection, Applicant describes the contents of the prior art references.

Dutt. This reference discloses a gasket formed as a portion of a cap for a container, where the material in the container is subject to spoilage or degeneration in the presence of air, and more particularly for food packing applications (Col. 1, lines 13 – 16). The cap 10 is threaded, snapped or crimped to the container. Col 2, lines 35 – 36. The cap gasket mates with an upstanding mouth or opening of the container in order to seal the contents of the container. There is no disclosure of whether the cap 10 is transparent. The Dutt reference has nothing to do with license plate covers, license plates or vehicles in general, and is provided for the entirely different purpose of hermetically sealing food, etc. in a container away from air. It has nothing to do with keeping a license plate clean and intact, and the illustrated container is not provided for exposure to mud, slush, road salt, etc. It is not art which is analogous to this invention, and a skilled routineer in the automotive aftermarket industry would not consult references in the food packing industry in

coming up with the present invention.

Leopold et al. Leopold et al. disclose a license plate cover with a flat, annular gasket of thermosetting rubber (that being the only sort of rubber in existence in 1927) which is meant to be mated to a peripheral bead of a license plate. The cover has mounting screw holes which are not closely laterally surrounded by gasket material. While the Leopold mounting screw holes are stepped, they do not operate as strain delimiters to prevent the overcompression of the gasket material and the fracturing of the cover. Leopold et al. do not disclose a channel at all, much less one provided for the injection molding of a gasket. They do not disclose any compression rib that is designed to be deformably compressed upon contact with the license plate. They do not disclose any material which is capable of being injection-molded into a channel.

Gonzalez. Gonzalez discloses a license plate illumination device (not a cover) in which a transparent, square-shaped (in section), annular channel surrounding the license plate is provided to house an illuminating high-voltage neon (or argon) tube. A back cover plate 40 is affixed to the channel and to the vehicle by mounting bolts (Col. 6, line 45). It does not show any sort of elastomeric gasket.

Means. Means discloses a license plate cover in which an annular gasket 90, 90'' of "resilient rubber or other suitable material" (Col. 4, Lines 64 – 66) is used to seal a peripheral edge of a license plate cover to a license plate. It does not disclose or suggest a channel into which an elastomeric gasket may be injection-molded, nor the class of thermoplastic elastomers which inherently must be used in the disclosed injection-molding process. The gasket 90 lacks any sort of compression rib, and does not closely surround any of the mounting screw holes.

Applicant's disclosure. The Examiner alleges that on page 8, paragraph 21 of his disclosure,

"Applicant admitted that the use of gaskets with ultraviolet inhibitors is known in the art." Applicant has reviewed the indicated passage and can find no such admission, either express or implied. Applicant stated, "the gasket 40 is formed from an elastomer, such as saniprene, or another organic rubber with an ultraviolet inhibitor." The gasket 40 is the gasket OF THE INVENTION, not a prior art gasket. Applicant knows of no prior art license plate cover formed with an elastomer capable of being injection-molded into a frame channel, nor of such an elastomer as including an ultraviolet inhibitor.

Yesbick. This disclosure is of a weatherproof frame for enclosing a photograph or the like, suitable for leaving at a gravesite. Is discloses a gasket 26 (Fig. 6) that laterally surrounds but does not contact the object to be protected (photograph 9), where both of these are sandwiched between a front frame plate 11 and a backing plate 25. The gasket 26 adheres to both frame plate 11 and backing plate 25. It does not occupy any sort of channel.

Having described the applied references, Applicant will discuss the Examiner's application of them to the claimed invention.

Rejection of Claims 11, 15 – 17, 2- 4 and 7 – 9 as anticipated by Leopold et al. First, the Examiner stretches the English language past its breaking point when he terms the entire rectangular inner side of the cover 2 that is laterally interior to the flange 3, and which matches the extent of the license plate that it covers, a "channel". This is not what a person of ordinary skill in this art would call a "channel" and would not interpret the "elongate channel" presented in, e.g., Claim 11 to read on such a large and wide structure. To clarify this point, Applicant has amended Claim 11 to recite an elongate channel disposed near the periphery of the frame and having a bottom and sides extending inwardly from the bottom towards the license plate. Applicant has separately called out a

central area that is disposed laterally interiorly of the channel. Independent Claim 15 has been amended similarly.

Second, while Leopold does indeed show a gasket, it doesn't show one which has been injection molded into the channel, so as to adhere to the bottom and sides of the channel. Were such a gasket to be formed this way in the Leopold structure, one couldn't see the license plate at all. Both independent claims 11 and 15 require this.

Third, Applicant must point out that in making an anticipation rejection, the Examiner is constrained by the four corners of the single reference he cites, and properties inherent in the described structure. When the Examiner says that the Leopold structure is "capable of" being "adhered" to the "channel", this doesn't go far enough. The Examiner must find within the Leopold reference a statement that the gasket does indeed adhere to the "channel", or something by which this property might be inferred (as by the recitation of an adhesive). Leopold et al. provide no such description. Leopold et al certainly do not show or suggest the sort of "adherence" required by claims 11, 15 and their dependencies, in which the adherence is caused by the step of injection molding a then-fluid elastomer into a channel, such that the solidified elastomer tightly and molecularly grips the channel's bottom and sides.

Relative to Claim 16, Applicant must respectfully disagree with the Examiner's characterization of the raised corner of Leopold et al.'s gasket (seen between lead lines 3 and 9 in Leopold et al.'s Figure 3) as a "compression rib". This raised corner is caused by the conformance of a featureless flat layer 10 of gasketing material to the sloped inner wall of flange 3. It is not a "rib" at all. Nor is it designed to deformably compress against the license plate, inherent in Applicant's use of the term "compression rib". Nor does it extend toward the license plate from a

generally planar gasket receiving surface, as Claim 16 now requires.

Relative to Claim 17, the Examiner claims that Leopold et al. shows four such compression ribs. Applicant sees no such compression ribs at all, certainly not any separable structures which extend inwardly in a direction toward the license plate from a receiving surface of the gasket, as Claim 17 now requires. The Figures in Leopold et al. show a flat, annular, ribless gasket being squeezed between the inner side of the license plate cover 2 on the one hand, and the peripheral bead 9 of the license plate 4 on the other. In section, the gasket of Leopold et al. is a simple rectangle, which "when the plate is pressed firmly against the gasket, the bead 9 will deform the latter against the body and flange of the holder, ..." Leopold et al., Col. 2, lines 79 – 83. Applicant shows permanent and conceptually separable compression ribs in its structure which will exist both before and after deformation by contact to the license plate.

Relative to Claim 2, Applicant has amended these claims to remove any question of what is meant by "inward": toward the license plate, which usually is parallel to the longitudinal axis of the vehicle. As noted above, Leopold et al. disclose a gasket without any compression ribs at all. Leopold et al. cannot suggest a structure having such ribs, much less one in which an inwardmost surface of a second compression rib is oriented in a plane inward relative to an inwardmost surface of the first compression rib.

Relative to Claim 9, Applicant reiterates that Leopold et al. disclose no compression ribs at all. It is therefore not possible to find two such compression ribs in the Leopold et al. structure, nor anything concerning their physical relationship to each other.

Relative to Claim 3, this claim, when read in conjunction of the claims from which it depends, recites a peripheral raised rim in addition to first and second compression ribs, structures

which are clearly absent in Leopold et al. The Examiner is double-counting the raised corner as one of the "ribs" recited in Claim 17, and a "raised rim" in Claim 3, dependent on Claim 17. The raised corner of the gasket in Leopold et al. fits neither. Claim 3 further has been amended to remove all doubt about the direction of "inward", and to point out that the rim extends inwardly from the gasket receiving surface.

Relative to Claim 4, the raised corner of the Leopold et al. gasket is not a "compression rib." It marks the lateral margin of the gasket, which appears to be die-cut from a sheet of precured material. The lateral margin is therefore 90 degrees from the plane of its general interior surface. A "v shape", as read in the context of the rest of the recited structure would present the point of an inverted V toward the license plate so that the point of the "v shape" will be deformed upon being pressed upon by the license plate. This does not happen in Leopold et al. The "V shaped" compression rib of this claim inherently has two surfaces, both sloped to the general interior surface of the gasket, which sloping surfaces intersect to make a line or point that is inward of the rest of the general interior surface of the gasket. Leopold et al. have no such structure.

Relative to Claim 7, Leopold et al. do indeed show stepped holes for the receipt of screw heads, but does not show any sort of strain delimiter function. Claim 7 has been amended to point out that each such hole has a sidewall of nongasket material which extends from a second level (the bottom of the screw head recess) inwardly to the plane of the general gasket receiving surface. In this way, when the screws are tightened, only the compression ribs deform, not the general layer of gasket material. This prevents the compressed gasket from cracking the frame.

Relative to Claim 8, the Examiner has stated that the "rib" surrounds a majority of the frame and that a portion of the bottom is open, pointing to "openings" 6. First, Leopold et al. do not show

any compression rib at all. Second, the Leopold et al. gasket is a complete annulus that shows no openings toward the bottom of the frame (downward in Leopold et al.'s Figure 1). In Applicant's structure as recited in Claim 8, the compression rib formed on the gasket is discontinuous, not necessarily all of the gasket. In the illustrated embodiment, the gasket is completely annular, but the ribs are intentionally discontinuous on the bottom edge of the frame. Leopold et al. show no rib at all, much less one that is discontinuous.

Rejection of Claim 18 as anticipated by Dutt. Applicant must first point out that Claim 18 recites a license plate cover, and manifestly Dutt does not disclose such. Since Dutt does not disclose each and every recited element in Claim 18, it cannot by law anticipate it. Applicant will treat the Examiner's rejection of Claim 18 as being obvious in view of Dutt.

As described above, the Dutt reference comes from an art which is not analogous to the area of endeavor – license plate covers -- to which the present invention pertains. Dutt is directed to a cylindrical bottle or jar for use in the food-packing industry. It describes a hermetically sealed container for preserving food or other substances which are subject to spoilage or contamination from air (in Applicant's preferred embodiment, the cover intentionally does not create such a hermetic seal). Dutt uses the gasket pointed out by the examiner to hermetically seal a cap to a mouth of a container.

The question is whether a person of ordinary skill in the art of license plate covers would look to the food packing industry for the claimed structure. The answer is clearly no. The Court of Appeals for the Federal Circuit has stated:

> Patent examination is necessarily conducted by hindsight, with complete knowledge of the applicant's invention, and the courts have recognized the subjective aspects of determining whether an inventor would reasonably be motivated to go to the field in which

> the examiner found the reference, in order to solve the problem confronting the inventor. ... It is necessary to consider the "reality of the circumstances", ... -- in other words, common sense – in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor... The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness.

In re Oetiker, 977 F. 2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The license plate cover of the present invention is used to keep slush, water, mud, sand, road salt and the like off of the face of a license plate which is affixed to a vehicle traveling through these adverse substances at highway speeds. The gasket provided by the invention has been injection-molded into a channel to make sure that it does not shift laterally with respect to the frame, and to ensure that it does not delaminate, under the hostile conditions to which it is subjected. It does this by providing a physical stop against lateral movement of the gasket and providing enhanced surface area for adherence of the injection-molded elastomer. There have been many prior art license plate covers, with gaskets but without channels, and the Examiner has cited a couple of them, the earliest being from 1928. Over the last seventy-six years, there have been none WITH a channel whose purpose is to have a gasket injection molded into it, despite the clear technical advantages that such a structure provides. The complete absence of such a structure in a license plate cover, over more than seventy-six years, is mute testimony of its nonobviousness; during all of that time, skilled routineers did NOT come up with a gasket which is injection molded into a channel cut into the license plate cover for this purpose. The presence of a channeled gasket on a bottle cap in an entirely different area of endeavor does not make the claimed license plate cover obvious.

Rejection of Claims 15, 10 and 11as obvious in view of Gonzalez and Means. The Examiner characterizes Gonzalez as showing a license plate cover. It doesn't. It is an open frame

which laterally surrounds a license plate, but doesn't cover it; it presents no barrier to slush, mud, etc. spattering on the face of the license plate. The "annular decorative insert" 20 is a high-voltage neon or argon illuminating fluorescent tube. The "sealing device" 40 closes the back of the channel, but does not perform any function in sealing the frame to the license plate, as the claimed gasket does. Interestingly, the "sealing device" 40 has to be secured to the channel member 30 and the rest of the vehicle by mounting bolts (Col. 6, lines 43 – 45). It is questionable whether the back plate 40 really has any sealing function; it merely forms the rest of the neon tube enclosure.

The Examiner cited to Means for Means's elastomeric gasket 90, 90". This gasket manifestly is not injection-molded into a channel, as Claims 15, 11 and all of their dependencies clearly require. The Examiner then states that it would have been obvious to modify Gonzalez by making the "sealing device" in the form of an elastomeric gasket since this would allow the channel to be sealed in a better and easier manner.

First, even supposing that this combination were proper, it does not result in Applicant's claimed invention. The elastomeric gasket might (somehow) seal up the back of the channel so as to protect the neon tube, but it would do nothing in sealing the frame to the license plate, which is the purpose of applicant's gasket. The resultant combination, an elastomerically sealed open license plate frame, would also fail in keeping the elements off of the face of the license plate.

Second, Claims 15 and 11 now require that the elastomeric gasket be injection molded into the channel to adhere to the sides and bottom of the channel. Neither Means nor Gonzalez discloses the structure created by injection molding, which creates a molecular interface between the vessel (in this case, a channel) into which the fluid elastomer is injected, and the sides and bottom of the vessel itself. Nor would it have been obvious to injection-mold an elastomer into Gonzalez's

channel. This is because Gonzalez provides his channel to hold a fluorescent tube which sends light outward toward other automobiles and laterally inward to illuminate the license plate. Putting an elastomer in Gonzalez's channel so as to adhere to its bottom and sides would occlude most or all of the light coming from the fluorescent tube, defeating the object of Gonzalez's invention, which is to illuminate rather than to seal. The combination of Gonzalez and Means is not proper, as there is no suggestion or motivation for their combination, and the existence of these two references does not render Claims 15, 11 and their dependencies obvious.

In regard to Claim 10, Gonzalez shows one annular channel, not two. No prior art reference exists that shows two channels which are parallel, spaced-apart and provided for injection-molding an elastomeric gasket into them.

Rejection of Claim 12 as obvious in view of a combination of Gonzalez, Means and Applicant's disclosure. Claim 12 is dependent on Claim 11, and the reasons for Claim 11's patentability over a combination of Means and Gonzalez apply with equal force here. In addition, Applicant has not admitted that the use of gaskets with ultraviolet inhibitors are known in the art. Rather, as has been discussed above, Applicant has stated that the gasket according to the invention has an ultraviolet inhibitor, not that other prior art gaskets did.

Rejection of Claim 12 as obvious in view of a combination of Leopold et al. and Applicant's disclosure. Claim 12 is dependent on Claim 11, and the reasons for Claim 11's patentability over Leopold et al. apply with equal force here. Nor does Applicant's disclosure cure any of Leopold et al.'s numerous shortcomings as a prior art reference. In addition, Applicant has not admitted that the use of gaskets with ultraviolet inhibitors are known in the art. Rather, as has been discussed above, Applicant has stated that the gasket according to the invention has an ultraviolet inhibitor,

not that other prior art gaskets did.

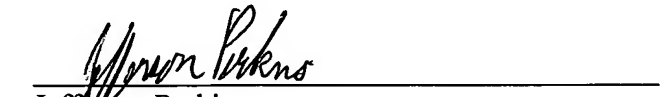
Rejection of Claim 18 as obvious in view of a combination of Leopold et al. and Yesbick. The Examiner states that Leopold et al. discloses the applicant's basic inventive concept except for adhering the gasket to the channel. The Examiner cites to Yesbick's adherence of his gasket 26 to his frame plate. This combination does not either disclose or render obvious the invention claimed in Claim 18.

Neither Leopold et al. nor Yesbick show a peripheral channel disposed laterally exterior to a central area of the frame. Neither Leopold et al. nor Yesbick et al. show an elastomeric gasket injection molded into such a channel, such that the gasket adheres to the bottom and sides of the channel. By Yesbick's recitation of a flat adhesive (peel-off tape, Col. 5, lines 27 – 28), this reference teaches away from using a nonflat surface topology, such as a channel, to aid in adhesion. In fact, neither Leopold et al. nor Yesbick disclose that class of thermoplastic elastomer that is even capable of being injection molded; both disclose gaskets that appear to be die-cut from flat, precured sheets of thermoset rubber. Claim 18 is not obvious in view of a combination of these references.

In summary, all of the claims as amended patentably define over the prior art. All other objections and rejections of the Examiner having been overcome, Applicant earnestly solicits a Notice of Allowance on the claims as amended.

Other than the fees for the Request for Continued Examination and Terminal Disclaimer, submitted herewith under cover of an enclosed fee transmittal, no fee is believed due in connection with the filing of this Amendment and Response. However, the Commissioner is hereby authorized to charge any deficiency to Deposit Account No. 503138 of Daspin & Aument, LLP.

Respectfully submitted,



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